

Application No.: 10/687,387

Docket No.: 66209-0001

### **REMARKS**

Applicant has reviewed the detailed Office Action mailed June 28, 2004, and thanks Examiner Olszewski for her review of the pending claims. In the Office Action, claims 1-14 have been rejected. Claims 1, 4-9, 11-12, and 14 have been amended. Claims 3, 10, and 13 have been canceled and incorporated into independent claims 1, 6, and 11, respectively. No new matter has been added. Thus, claims 1-2, 4-9, 11-12, and 14 are now pending in this application. Applicant respectfully requests reconsideration of the pending claims in light the preceding amendments and the following remarks.

### **Objections to the Specification**

#### **Abstract**

The Applicant has amended the abstract to correct the informalities objected to by the Examiner. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the objection.

### **Claim Rejections Under 35 U.S.C. §112**

#### **Rejection under 35 U.S.C. §112, Second Paragraph**

Claims 4 and 5 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner cites insufficient antecedent basis for the limitation "said religious sacrament."

Applicant has amended claim 4 to correct this deficiency, rendering claims 4 and 5 in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

### **Claim Rejections Under 35 U.S.C. §102**

Claims 1, 2, 4, 6, 7, 9, 11 and 12 were rejected under 35 U.S.C. §102(a) as being clearly anticipated by O'Callaghan (U.S. Patent No. 2,748,577) and as best understood in light of the 35 U.S.C. §112 second paragraph rejection above. Applicant respectfully traverses the rejection.

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Independent claims 1, 6, and 11 have been amended to more clearly articulate certain aspects of the invention. Particularly, claims 1, 6, and 11 have been amended to include the limitations of now canceled claims 3, 10, and 13, respectively. As such, independent claims 1, 6, and 11 now include the limitation of the cloth being made of wool, which as the Examiner has noted on page 4 of the Office Action, is not specifically stated in O'Callaghan and therefore does not anticipate the claims as amended.

Accordingly, for at least the reasons set forth above, independent claims 1, 6, and 11, as amended, are in condition for allowance. For at least the same reasons, claims 2, 4, 7, 9 and 12, which depend from independent claims 1, 6, and 11, are also in condition for allowance. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection.

### Claim Rejections Under 35 USC §103

#### Rejection of Claims 3, 10, and 13

Claims 3, 10 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over O'Callaghan. Applicant has canceled dependent claims 3, 10, and 13 and incorporated the subject matter into independent claims 1, 6, and 11, respectively. The rejection is respectfully traversed.

The Examiner has rejected the limitation of wool in claims 3, 10, and 13, which is now incorporated into independent claims 1, 6, and 11, respectively, as being obvious in view of O'Callaghan, yet, as the Examiner expressly acknowledges, O'Callaghan never specifically states that the brown cloth is, or can be, wool. Further, the Examiner states, that "[w]ool is an old and well known material and to form the brown cloth of O'Callaghan from wool would be obvious and considered well within the level of skill of one in the art since it is merely a well known equivalent." Applicant respectfully disagrees with the Examiner's position and submits that a rejection on this basis is improper.

The Federal Circuit has stated that, "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 23 USPQ2d

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1780, 1783-84 (Fed. Cir. 1992). "When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination." *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 30 USPQ2d 1377, 1379-80 (Fed. Cir. 1994).

In the present case, O'Callaghan never mentions wool, or implies that wool is a possible alternative. O'Callaghan merely discloses the use of a brown cloth. Applicant, however, claims a piece of wool cloth that can be made of various colors, depending on the religious preferences of the person wearing the scapular. (See the Specification, page 5, paragraph 19, lines 7-8).

For at least these reasons, Applicant submits that claims 1, 6, and 11, which incorporate the limitations of rejected and canceled claims 3, 10, and 13, are not obvious and allowable over the cited art. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

#### Rejection of Claims 5, 8, and 14

Claims 5, 8 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over O'Callaghan in view of Herck (U.S. Patent No. 2,422,678). Applicant respectfully traverses the rejection.

Claims 5, 8, and 14 depend from independent claims 1, 6, and 11, respectively, which Applicant believes to be in condition for allowance. For at least this reason, claims 5, 8, and 14 are also in condition for allowance. However, Applicant submits that dependent claims 5, 8, and 14 define over the prior art references independently of their dependence from base claims 1, 6, and 11, respectively.

The Examiner has rejected claims 5, 8, and 14 as being unpatentable over O'Callaghan in view of Herck stating that, "O'Callaghan discloses all the claimed features as discussed in the rejections above except for the pendants including an opening exposing the pieces of cloth from within the cavities. However, Herck discloses an open space (26) for exposing an object." (See the Office Action at page 4). The Federal Circuit has stated that, "The combination of elements from non-analogous sources, in a manner that reconstructs the

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applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill ... would make the combination. That knowledge can not come from the applicant's invention itself." *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992).

Applicant submits that there is no reason, suggestion, or motivation to combine the non-analogous teachings of the scapular of O'Callaghan with the coin holder of Herck. The invention as claimed by Applicant was designed with a specific religious significance in mind. The opening, in particular, provides the necessary access that allows the wearer to be in contact with the wool cloth. This purpose and religious significance would not have been obvious in light of a piece of jewelry, which has an opening that holds a coin, as taught in Herck. The fact that both the claimed invention and O'Callaghan each have an opening does not make the combination as claimed obvious.

Therefore, the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. §103. Claims 5, 8, and 14, for at least these reasons, are patentable. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.

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**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 66209-0001 from which the undersigned is authorized to draw.

Dated: October 28, 2004

Respectfully submitted,

By 

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